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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Meritage Real Estate Development Group, Inc.
v.
Andrie F. Grimaud and Michael R. Marquardt

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Opposition No. 9116276 to application Serial No. 781800707
filed on October 31, 2002

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Michael J. Tunink of Tunink Law Firm for Meritage Real Estate Development Group, Inc.

Christopher J. Day of Law Office of Christopher Day for Andrie F. Grimaud and Michael R. Marquardt.

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Before Hohein, Walters and Grendel Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Andrie F. Grimaud and Michael R. Marquardt, hereinafter collectively referred to in the singular as "applicant," have filed an application to register the mark "STORE MORE! SELF STORAGE" and design, as shown below,

for "providing self storage or mini storage services."[1]

[1] Ser. No. 78180707, filed on October 31, 2002, which alleges a date of first use anywhere of September 1, 2002 and a date of first use in commerce of September 2, 2002. The terms "STORE" and "SELF STORAGE" are disclaimed.

Meritage Real Estate Development Group, Inc., hereinafter referred to as "opposer," has opposed registration on the ground that prior to both the filing date of applicant's application and "[a]pplicant's alleged [first] use date of September 1, 2002, Opposer has been, and is now, using the trademark 'STORE MORE AMERICA' ... since at least February 1, 2002, in connection with storage services and facilities"; that such use "has been valid and continuous since February 1, 2002, and has not been abandoned"; that opposer has "filed an application in the USPTO to register Opposer's mark 'STORE MORE AMERICA' on November 21, 2003, for the services of 'storage services, namely, refrigerator storage, wine storage, wine barrel storage, cigar storage, vehicle storage, warehouse storage, and providing storage space," which was "assigned Serial No. 76561594"; that in an "Office Action dated April 6, 2004, the USPTO has refused registration of Opposer's mark, in part, based on a likelihood of confusion with Applicant's mark"; and that "[i]n view of the similarity of Opposer's mark and Applicant's mark, the identical or closely-related nature of the services , and the similar channels of trade, ... Applicant's mark so resembles Opposer's mark [as] previously used in the United States, and not abandoned, that Applicant's mark is likely to cause confusion, or to cause mistake, or deception with Opposer's mark."

Applicant, in its answer, has admitted the allegations that opposer has filed application Ser. No. 76561594 in the USPTO on November 21, 2003 to register the mark "STORE MORE AMERICA"

for the various storage services identified in connection therewith and that the USPTO has refused registration of such mark in an Office Action dated April 6, 2004 based, in part, on a likelihood of confusion with Applicant's mark, but has otherwise denied the salient allegations of the notice of opposition, including the allegations opposer has had prior use of its mark since at least February 1, 2002 in connection with storage services and facilities, that such use has been valid and continuous, and that opposer's mark has not been abandoned.

The record consists of the pleadings; the file of applicant's involved application; and, as opposer's case-in-chief, a notice of reliance on, among other things, "[e]xcerpts from the April 2002 Issue of SBC Pacific Bell Smart Yellow Pages published for Santa Cruz County, California," which opposer asserts are "relevant to show that Opposer's first use [anywhere] and first use in commerce of Opposer's STORE MORE AMERICA mark occurred prior in time to Applicant's alleged first use of Applicant's Mark," and certain official USPTO records pertaining to application Ser. No. 76561594, which opposer maintains are "relevant to show that Applicant's Mark has been cited by the USPTO as grounds for the potential refusal to register Opposer's Mark" and that "[o]pposer's application has been suspended pending the disposition of Applicant's application." Applicant did not submit any evidence. Only opposer filed a brief and neither party requested an oral hearing.

The issues to be determined on this record are whether the evidence of record establishes that opposer has priority of

use and is the owner of the "STORE MORE AMERICA" mark and, if so, whether applicant's "STORE MORE! SELF STORAGE" and design mark for it services of "providing self storage or mini storage services" so resembles opposer's "STORE MORE AMERICA" mark for opposer's various storage services as to be likely to cause confusion as to the source or sponsorship of the parties' respective services.[2]

Turning first to whether the record establishes that opposer has priority of use and is the owner of its pleaded "STORE MORE AMERICA" mark for the various storage services which it has alleged, we note that the official records of the USPTO which opposer made of record by its notice of reliance, and upon which it solely relies in its brief, show on their face that with respect to an Office Action issued on April 6, 2004 in connection with application Ser. No. 76561594, such application is for registration of the mark "STORE MORE AMERICA" for "storage services" and identifies the applicant therein as "Meritage Real Estate Development Group, ETC."[3] Further, such action, in part, indicates that "[t]here may be a likelihood of confusion between the applicant's mark" and, *inter alia*, the mark which is the subject matter of application Ser. No. "78180707," which is

[2] It is noted that opposer, in its statement of the issues in its brief, frames the issues herein as follows: "Whether Opposer's Mark had a date of 'first use' and a date of 'first use in commerce' that preceded the dates of Applicant's Mark"; and "[w]hether there is a likelihood of confusion between Opposer's Mark and Applicant's Mark."

[3] Such name is clearly that of opposer, Meritage Real Estate Development Group, Inc., inasmuch as it is obvious that because of the length of opposer's name, the USPTO has simply truncated the name due to space limitations in the standardized format of Office Action captions.

indeed the application which opposer has opposed in this proceeding. Such action, citing Trademark Rule 2.83, also indicates that because "[t]he filing dates of the [several] referenced applications," including application Ser. No. 78180707, "precede the applicant's filing date," "the examining attorney may refuse registration in this case under Section 2(d) [of the Trademark Act]," on the basis of likelihood of confusion, "[i]f one or more of the referenced applications matures into a registration." In addition, a "NOTICE OF SUSPENSION," issued on June 22, 2005 in connection with application Ser. No. 76561594, filed by "Meritage Real Estate Development Group, ETC.," states on its face that "[a]ction on this application is suspended pending the disposition of, *inter alia*, "Application Serial No(s). 78180701," which opposer insists in its notice of reliance is a typographical error which is meant instead to refer to application Ser. No. 78180707,[4] and that because opposer's "effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application."

Moreover, although not relied upon or otherwise even mentioned by opposer in its brief, the record in any event contains the previously noted admissions by applicant in its answer that opposer has filed application Ser. No. 76561594 in the USPTO on November 21, 2003 to register the mark "STORE MORE

[4] Specifically, opposer contends therein that "the Notice of Suspension incorrectly identifies Applicant's application as Application Serial No. 78/180701, even though the correct number is Application Serial No. 78/180707."

AMERICA" for the various storage services, including "providing storage space," alleged by opposer with respect thereto in the notice of opposition and that the USPTO has refused registration of such mark in an Office Action dated April 6, 2004 based, in part, on a likelihood of confusion with Applicant's mark. These admissions, irrespective of the evidence discussed above from opposer's notice of reliance, are sufficient to establish that opposer not only has a proprietary interest in the mark "STORE MORE AMERICA" for the services of "providing storage space", but it has standing to bring this proceeding because its application to register such mark has been refused in light of applicant's prior-filed involved application for the mark "STORE MORE! SELF STORAGE" and design for legally identical services of "providing self storage or mini storage services." See, e.g., Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) [to have standing, "it would be sufficient that appellee prove that it filed an application and that a rejection was made because of appellant's registration"]. However, neither applicant's admissions in its answer nor the above discussed evidence provided by opposer with its notice of reliance constitutes proof that opposer has priority with respect to its mark, that is, it possesses an equal or superior right to the use thereof vis-à-vis applicant.

Rather, as to opposer's alleged prior use of its pleaded "STORE MORE AMERICA" mark, opposer asserts in its brief that its "first use of Opposer's Mark occurred six months before

Applicant's first use date." Opposer, in particular, claims that (italics in original):

> In its application and subsequent amendment, Opposer alleged that its "first use" date and date of "first use in commerce" was February 1, 2002, which was six months before Applicant's first use date in September 2002. (See Opposer's trademark application file.)
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> Opposer's dates of first use are confirmed in evidence submitted by Opposer in this proceeding, namely excerpts from the SBC Pacific Bell Smart Yellow Pages showing that Opposer performed advertising of Opposer's STORE MORE AMERICA mark in connection with Opposer's storage services, which advertising occurred approximately six months before Applicant's own self-admitted first use date in September 2002. (See Exhibit A to Opposer's Notice of Reliance.) Applicant has not submitted any evidence whatsoever to contradict that Opposer's first use date preceded Applicant's first use date.
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> ....
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> Applicant's failure to provide any evidence whatsoever of the actual use of Applicant's Mark carries further evidentiary penalties. With respect to the matter of prior use and the obligation of parties in opposition proceedings to provide evidence, 35 CFR §2.122(b)(2), provides:
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> > The allegation in an application for registration ... of a date of use is not evidence on behalf of the applicant ...; *a date of use of a mark must be established by competent evidence.* Specimens in the file of an application for registration ... are not evidence on behalf of the applicant ... unless identified and introduced in evidence as exhibits during the period for taking of testimony.
>
> With respect to submission of evidence of use in opposition proceedings, McCarthy states that, "if the applicant in an opposition proceeding introduces no evidence of prior use, then the earliest date of first use to which it is entitled is the filing date of

> its use-based application." *McCarthy [on Trademarks & Unfair Competition]*, 3rd ed., §20.09[1] ....
>
> During the testimony period herein, Applicant did not submit any evidence or testimony to substantiate or corroborate any use date of Applicant's Mark. As a result, Applicant may only rely on its application filing date of October 31, 2002, as it priority date, and cannot rely on its alleged first use dates in September 2002 mentioned in Applicant's application.
>
> Regardless of what date one assumes Applicant had first use--either the September 2002 allegation in Applicant's application, or the October 31, 2002 filing date of Applicant's application--the evidence ... has established that Opposer's first use occurred in early-2002, which was approximately six months before Applicant's alleged first use. Because Opposer's use of Opposer's Mark occurred prior to any use of Applicant's Mark, this case should be resolved against the newcomer (Applicant) and in favor of the prior user (Opposer).

Opposer is correct that because applicant has neither taken testimony nor otherwise submitted any proof of its alleged dates of first use anywhere and in commerce of, respectively, September 1, 2002 and September 2, 2002, the earliest date upon which applicant is entitled to rely in this proceeding, for purposes of priority, is the October 31, 2002 filing date of its involved application. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); and Miss Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). Contrary to opposer's arguments, however, it has failed to prove a date of first use of its "STORE MORE AMERICA" mark for providing storage services which is as

early as, or earlier than, applicant's priority date of October 31, 2002 and therefore cannot prevail in this proceeding.

Specifically, opposer is incorrect in its assertion in its brief that its "trademark application file," namely, Ser. No. 76561594, is of record in this proceeding; instead, only certain excerpts from such file--a copy of an Office Action issued on April 6, 2004 and a copy of a notice of suspension issued on June 22, 2005--are of record by virtue of opposer's notice of reliance thereon as official records of the USPTO.[5] Neither of those papers sets forth any date of first use of opposer's pleaded "STORE MORE AMERICA" mark and, even if such were the case, Trademark Rule 2.122(b)(2) provides, as correctly noted by opposer in the case of applicant's involved application, that any date of first use alleged in an application "is not evidence on behalf of the applicant" but instead "must be established by competent evidence." Neither of such papers, moreover, indicates a specific filing date for opposer's application; instead (and aside from the hearsay nature of such documents when considered for the truth of the statements appearing therein), each paper refers only to the generalized fact that the filing date of opposer's application is *subsequent* to, *inter alia*, the filing date of what is presently the application involved in this proceeding.

[5] While applicant's involved application is automatically of record pursuant to Trademark Rule 2.122(b)(1), it is pointed out that such rule does not operate to make opposer's application of record herein inasmuch as the language thereof pertains in relevant part solely to the file "of the application against which a notice of opposition is filed."

Although, for the purpose of establishing priority of use, opposer principally relies upon copies of three pages from the SBC Pacific Bell Smart Yellow Pages as serving to confirm its alleged February 1, 2002 date of first use of its "STORE MORE AMERICA" mark anywhere and in commerce for providing storage services or, at a minimum, demonstrating its use thereof at least six months before the October 31, 2002 filing date of applicant's involved application, such evidence fails to support opposer's position. The yellow pages excerpts consist of the front cover of an "April 2002 Issue" of a telephone directory for "Santa Cruz County; a full page display ad on page 688 thereof under the heading "Storage" which touts "STOREMORE America™" as "YOUR SECURE STORAGE SOLUTION" with, among other things, "STATE OF THE ART FACILITIES"; and a separate listing on page 697 under the heading "Storage - Self Service" of "STOREMORE AMERICA" which includes the reference to "*See Display Ad Page 688*." However, aside from the fact that the service mark illustrated is "STOREMORE AMERICA" rather than "STORE MORE AMERICA" as alleged by opposer in the notice of opposition (as well as the hearsay nature of such excerpts when considered for the truth of the statements appearing therein), there is nothing in the excerpts which demonstrates that the advertisement and listing were placed by opposer and that the services being promoted are indeed being offered or rendered by opposer. Nothing in such excerpts proves the following statements in opposer's notice of reliance, which in essence are unsworn testimony by which opposer claims that the excerpts establish prior use *by opposer* (emphasis added):

> .... Excerpts from the April 2002 issue of SBC Pacific Bell Smart Yellow Pages published for Santa Cruz County, California, *showing publication of Opposer's STORE MORE AMERICA mark* .... Page 697 *shows Opposer's STORE MORE AMERICA mark* under the Yellow Pages category entitled "Storage-Self Service"; after *Opposer's listing* on page 697 are the words: See Display Ad Page 688"; Page 688 shows the mark in a full page advertisement that publicizes *Opposer's services* and other relevant information. Among other things, this printed publication is relevant to show that *Opposer's first use and first use in commerce of Opposer's STORE MORE AMERICA mark* occurred prior in time to Applicant's Mark. ....

Given such failure of proof of priority of use by opposer, as the party bearing the burden of proof in this proceeding,[6] it cannot prevail herein on its claim of priority of use and likelihood of confusion even assuming that the record otherwise is sufficient to establish that there is a likelihood of confusion from contemporaneous use by opposer of the mark "STORE MORE AMERICA" for providing storage services and by applicant of the mark "STORE MORE! SELF STORAGE" and design for providing self storage or mini storage services.

Decision: The opposition is dismissed.

[6] See, e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards, 143 F.3d 1373, 47 USPQ2d 1459, 1464 (Fed. Cir. 1998) (Michel, J. concurring); Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988); Sanyo Watch Co., Inc. v. Sanyo Elec. Co., Ltd., 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982); and Clinton Detergent Co. v. Proctor & Gamble Co., 302 F.2d 745, 133 USPQ 520, 522 (CCPA 1962).